REMARKS:

Claims 25-34, 36 and 37

Claims 25-34, 36 and 37 have been rejected under 35 USC 102(b) as being anticipated by Rose et al. (US 2001/0013991).

Applicants respectfully disagree that Rose teaches each and every limitation of claim 25. The rejection of claim 25 relies primarily on FIG. 3 of Rose to show all of the claimed features. A marked-up version of Rose's FIG. 3 from the Office Action dated Oct. 3, 2005 is reproduced below:

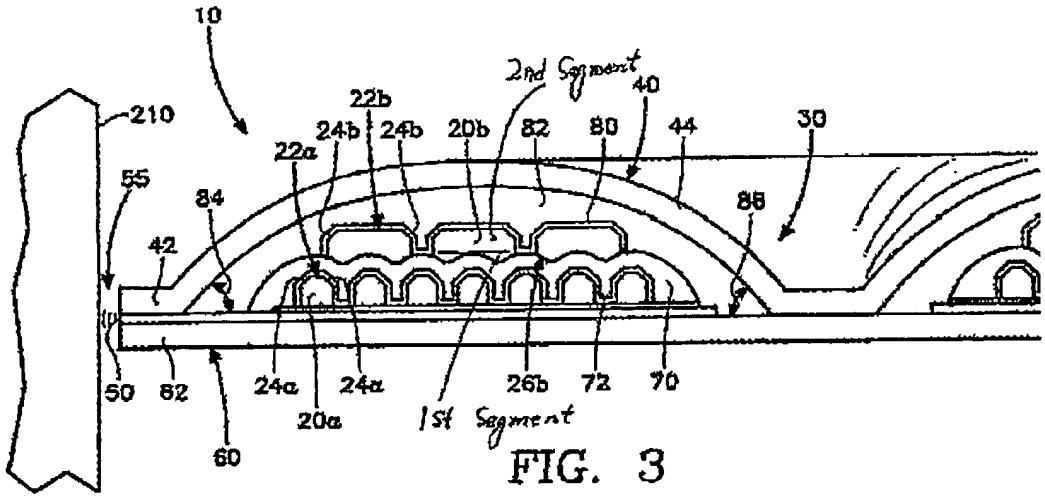

FIG. 3

Claim 25 requires that the photoresist layer be positioned adjacent an insulating layer and define a channel. Claim 25 further requires that a profile of the channel include first and second segments each having a different angle. Looking to the marked-up version of Rose's FIG. 3 above, the first segment marked by the Examiner is not defined by the photoresist layer 82, but rather is defined by insulating layer 70. Thus, the first segment indicated by Rose does not anticipate the first segment of claim 25, as

Rose's first segment is defined by insulating layer 70 rather than by a photoresist layer as claimed.

That the claimed channel segments are defined by the photoresist is clear from the language of the claim. Further, as required by MPEP Section 2111, the Examiner must give the claims their broadest reasonable interpretation in light of the specification. Referring to the present application, the head structure described in the specification includes channels 412 defined by the photoresist layer 410. Each channel defined by the photoresist layer has multiple segments 430, 432. Note the following quote from p. 11, lines 1-6 and related Figure:

> As shown , the channels **412** include multiple segments each defining different wall angles, in order to overcome the deficiencies of the prior art and improve the aspect ratios of a resultant coil structure. In particular, each channel **412** includes a first segment **430** defining a first angle and a second segment **432** defining a second angle. The first segment **430** of each channel **412** may be positioned below the corresponding second segment **432**.

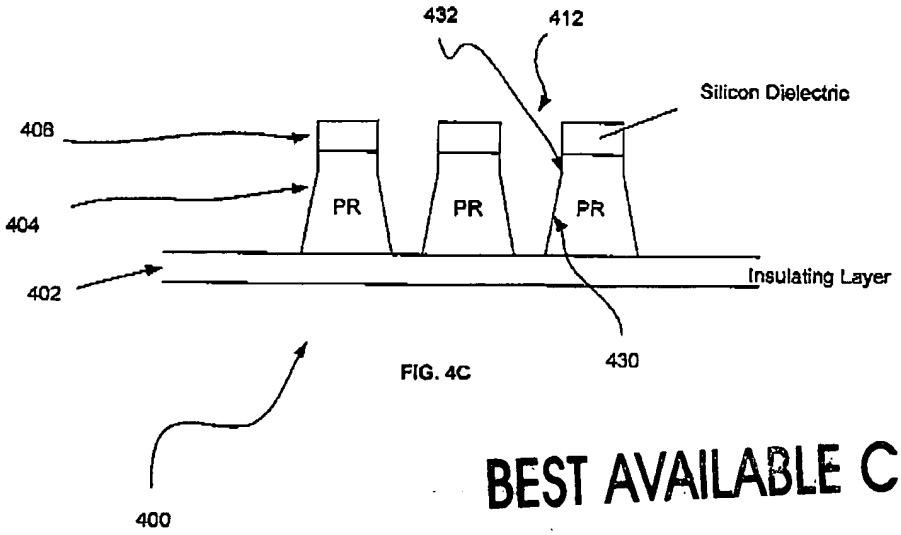

FIG. 4C

The specification clearly indicates that the channel segments 430, 432 are defined by the photoresist layer. Therefore, it would not be reasonable to equate Rose's first segment

defined by an insulating layer with the first segment defined by the photoresist layer of the claimed invention, in light of the specification.

By defining the channel segments with the photoresist layer, a high aspect ratio can be achieved without the problems associated with milling the structure to define the coil structure, e.g., shorting.

Further, the photoresist structures having the angles claimed in claims 27-31 provide an additional benefit in that they are more stable, i.e., less prone to breaking or tipping over during processing.

Claims 26-34 depend from claim 25 and are therefore also believed to be allowable.

Claims 36 and 37 include similar limitations as claim 25. Therefore claims 36 and 37 are believed to be allowable for the same reasons presented above with respect to claim 25.

Claim 35

Claim 35 has been rejected under 35 USC 103(a) as being unpatentable over Rose in view of Hsiao et al (US 6570739).

Because parent claim 25 is believed to be allowable over Hsu, and Hsiao has merely been added to show additional features, claim 35 is also believed to be allowable. Reconsideration and allowance of claim 35 is respectfully requested.

Additionally, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). In the instant case, Rose indicates that conductor 22b, the only conductor near the photoresist 82, is preferred to be larger than

the lower conductor 22a. *See* Rose [0042]. Further, Rose's wider upper conductor lowers winding inductance and improves rise time, thereby improving operating frequency. *See* Rose [0045]. Accordingly, the addition of Hsiao's high aspect ratio coils would provide no additional benefit. Further, the motivation for adding Hsiao's high aspect ratio coils as cited by the Examiner is already provided by the upper conductor 22b as stated in Rose [0045], and so there is no motivation to replace Rose's upper conductor 22b with Hsiao's coils.

Applicants also argue that Rose teaches away from the high aspect ratio coils of Hsiao. Again, Rose [0042] indicates that the upper conductor 22b, the only conductor near the photoresist 82, is preferred to be larger than the lower conductor 22a. Rose [0044] goes on to indicate that the wider upper conductor 22b minimizes the combined height of the upper and lower conductors 20a and 20b. This improves yoke material deposition and improves operating frequency. Accordingly, Rose teaches away from high aspect ratio conductors in order to minimize the combined height of the upper and lower conductors 20a and 20b. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)

For any of the foregoing reasons, claim 35 is believed to be allowable over the art of record.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. HSJ9-2003-0045US1).

Respectfully submitted,

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